AF/2859
#12
Appeal Brief
SDavis
8/12/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Scott D. Landes	Attorney File:	5482
Serial No.:	09/710,966 ✓	Examiner:	Courson
Filed:	11/14/00 ✓	Group:	2859
For:	Anchoring Marker Post ✓		

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on July 24, 2003 by applicant's attorney, Carl L. Johnson.

Carl L. Johnson

July 24, 2003
Date

Commissioner For Patents
Alexandria, VA 22313-1450

APPEAL BRIEF COVER LETTER

Dear Sir/Madame:

Enclosed is an appeal brief that the applicant is submitting for the above-identified patent application under 37 C.F.R. 1.17(C). The applicant has included three (3) copies of the appeal brief along with a check in the amount of $160.00 for the appeal brief filing fee. The applicant does not wish to request for an oral hearing. The applicant is a small entity.

Please charge any deficiency in fees to deposit account 10-0210.

Respectfully submitted,

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By

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CLJ/cj
Enclosure

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Scott D. Landes	Attorney File:	5482
Serial No.:	09/710,966	Examiner:	Courson, Tania C
Filed:	11/14/2000	Group:	2859
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Carl L. Johnson

July 24, 2003
Date

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT'S APPEAL BRIEF

Sir:

I. REAL PARTY IN INTEREST

The real party in interest is REPNET, Inc., assignee of U.S. patent application serial number 09/710,966; filed on November 14, 2000; and titled Anchoring Marker Post.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the above-identified patent application.

III. STATUS OF CLAIMS

Claims 1-12 to an anchoring marker post have been rejected final.

IV. STATUS OF AMENDMENTS AFTER FINAL

The above-identified application was rejected final on March 28, 2003. In response to the Examiner's final rejection of March 28, 2003, a Notice of Appeal was filed with the Patent Office on May 27, 2003.

V. SUMMARY OF INVENTION

The present invention comprises a hollow one piece anchoring marker post. The marker post is composed of a polymer plastic that is flexibly resilient and weather resistant. Integrally attached to the marker post is a set of anchoring flaps. The anchoring flaps are moveable from a first closed position for facilitating the handling and transportation of the marker post to a second open position for preventing the withdrawal of the marker post from an embedded position. The flaps, when embedded in the opened position, use the weight of the topsoil to create a resistance against the up lifting of the post. With the flaps integrally connected to the marker post there are no additional parts to attach to the marker post thus resulting in fewer parts to lose.

VI. ISSUES

1. Whether it would have been obvious for one having ordinary skill in the art of marking post to look to the art of piling for supporting building or similar housing structures thereon to solve the problem of preventing withdrawal of an embedded Marking Post from a soil surface?

2. Whether the Applicant's marker post comprising an elongated member composed of a flexibly resilient polymer plastic is made obvious by Hanson's metal piling?

3. Whether the flexible living hinges of the Applicant's marker post are made obvious by the anchor tabs of Hanson's metal piling pipe?

4. Whether the reference of Hanson teaches a marker post having anchoring flaps moveable from a first closed position to a second open position wherein the flaps have "sufficient memory to stay in the open position until the post can be embedded" within a top soil to prevent the withdrawal of said elongated member from an embedded position?

VII. GROUPING OF CLAIMS

Claims 1 and 8 each stands alone on its own. While claims 2-7 and 11-12 rely on claim 1 and claims 9-10 rely on claim 8, each of claims 2-7 and 9-12 also stands alone on their own.

VIII. ARGUMENT

In the Office Action dated March 28, 2003, the Examiner rejected claims 1-12 under 35 U.S.C. 103(a) as being anticipated by the reference of Hanson (U.S. Patent No. 5,494,378).

1. **It would not have been obvious to one in the art of Marking Posts to look to the art of piling for supporting building or similar housing structures thereon to solve the problem of preventing withdrawal of an embedded Marking Post from a soil surface.**

Applicant's claims 1-12 stand rejected as being made obvious by the reference of Hanson. The Applicant respectfully disagrees with the Examiner's rejection of Applicant's claims 1-12 as being obvious based on the reference of Hanson.

The reference of Hanson teaches a below ground piling used to support a "building or similar housing structures" thereon.[1] The Applicant does not provide a piling that is used to support a building or similar housing structure thereon. Applicant, instead, provides an above ground marker that is used to alert people to the presence of an underground utility line.

Hanson explains in column 1, lines 12-14 that in certain areas the "soil does not have the desired consistency to alone support the weight of such structures." Thus the purpose of the Hanson piling is to provide additional support for an above ground load. In contrast to Hanson's piling, the Applicant's invention is not for providing additional support for an

[1] See column 1, line 8 of Hanson.

above ground load but instead is for preventing withdrawal of an embedded marking post from the soil surface.

Hanson goes on to explain that there are two forces used to support his piling, "the friction forces applied to the vertical walls of the piling" and the "upward force applied to the bottom face of the piling by the soil (the end force)." [2] In column 1, lines 23-28, Hanson explains:

> "Because the friction force applied to a typical piling is much less than the requisite amount of support a structure requires, the end force must therefore supply the difference." (Emphasis added)

Hanson further explains that to obtain the necessary "end support," Hanson requires the use of "a conical driving penetration point 20" located on the bottom end 15 of his piling [3], which Hanson points out is "welded into position"[4] thus closing the end of his piling. In contrast to the reference of Hanson, Applicant teaches a Marker Post which does not have a "conical driving penetration point 20" welded into position. Note that Applicant's claim 8 specifically points out that the Applicant has an open end on the Applicant's Marker Post, a feature that would defeat the critical "end support" requirement of the Hanson piling.

In addition, Hanson specifically states that his piling provides support for an above ground building that weighs "many tons"[5] while the Applicant provides a Marker Post, not to

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[2] See *id.* at column 1 lines 21-24.

[3] See *id.* at column 4, lines 1-3.

[4] See *id.* at column 4, line 38.

[5] See *id.* at column 1, lines 10-11.

support "many tons," but to resist withdrawal from the ground due to acts of vandalism or storms. Note on page 2 lines 8-9 in which Applicant states that the:

> "Marker posts are used to place as an above ground warning that an underground pipe or electric line is buried in the soil." (Emphasis added).

Thus, the teachings of the Hanson "piling" and the Applicants "Marker Post" are not only different but are in opposite directions given that Hanson's piling is used to support an above ground building whereas Applicant's Marker post is used to mark the existence of a below ground utility line. In addition, while Hanson's needs to provide additional support for an above ground building to prevent his piling from sinking, Applicant's purpose is to the contrary, namely, to prevent withdrawal of the Marker Post due to vandalism or storm damage.[6]

Further note that Hanson and Applicant are concerned with opposite forces. Hanson is concerned with the downward forces on his piling while the Applicant is concerned with the exact opposite, namely the upward forces acting on the Applicant's Marker Post.

In addition, note that the Hanson piling is inoperable unless he places charges 22 on the inside of his fingers since Hanson requires the detonation of his explosive charges to bend his fingers outward with sufficient force to exceed the elastic limit of his metal.[7] In contrast to the reference of Hanson, Applicant requires no explosive charges to position the Applicant's

[6] See page 2, lines 17-19 of the Applicant's disclosure.

[7] See column 3, lines 1-4 and 14-25 of Hanson.

anchoring flaps since Applicant uses a living hinge, which does not require one to exceed the elastic limits of the material of the marker post. Thus it is submitted that the marker post of Applicant's claims 1-12 are not made obvious in view of Hanson since Hanson requires explosive charges as an integral part of his piling and Applicant does not require explosive charges. It is further submitted that one seeking to solve the problem of marker post withdrawal would not look to the art of piling for supporting a housing structure thereon, much less to an art that teaches one that explosives are needed to obtain additional support for the piling.

In further regards to the Applicant's invention, Applicant also was faced with the problem of stacking the Applicant's marking posts for shipping. In order to conveniently stack the marking posts for shipping it is desirable not to have any protrusions on the side of the post. However, without the protrusions on the side of the marking post, there is nothing to prevent their withdrawal from the embedded position. Applicant's invention solves the aforementioned problem by using resilient material that supports living hinges. The living hinges being comprise of a resilient material permits the Applicant's flaps to be:

> "moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said elongated member from an embedded position whereby the flaps has a sufficient memory to stay in the open position until the post can be embedded." [8] (Emphasis added.)

It is submitted that the reference of Hanson is not concerned with the problem of protrusions on the side of Hanson's piling pipe hindering the handling and transportation of Hanson's

[8] See Applicant's claim 8.

piling pipe as the sidewall of Hanson's piling pipe is designed to be in a smooth condition for embedment "to minimize the frictional resistance of driving thereof to its embedded support position."[9] (Emphasis added.)

In view of the above, Applicant submits that it would not be obvious to one in the art of marker posts that extend above ground to caution a person on the existence of an underground power line to have to look to a different art namely, to the art of piling for supporting building or similar housing structures weighing may tons thereon to come up with a solution to a problem not even present in the piling art, namely retentions of marker posts due to storms and vandalism while still providing a Marking Post that can be stacked for shipping.

2. The Applicant's marker post comprising an elongated member composed of a flexibly resilient polymer plastic is not made obvious by Hanson's metal piling.

Applicant's claims 1 and 8 each call for an "elongated member composed of a flexibly resilient polymer plastic." Applicant's claims 3 and 9 further discloses that the "polymer plastic is polycarbonate or polyethylene." On page 5, lines 14-16 of the Office Action Dated March 28, 2003, the Examiner stated:

> "Hanson does not disclose said elongated member composed of a flexibly resilient polymer plastic, wherein said polymer plastic is polycarbonate or polyethylene and a triangular shaped elongated member." (Emphasis added.)

The Applicant agrees with the Examiner's above statement.

[9] See column 3, lines 8-13 of Hanson.

However, in rejecting Applicant's claims 1, 3, 8, and 9 as being made obvious by the reference of Hanson, the Examiner further stated:

> "Regarding claims 1, 3, 8, and 9: Hanson discloses the elongated member (hollow pipe 12) made of metallic (column 3, lines 25-26) materials. The particular type of material used to make the elongate member, absent any criticality, is only considered to be the use of a "preferred" or "optimum" material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) wherein the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious." [10] (Emphasis added.)

The Applicant disagrees with the Examiner's rejection of Applicant's claims 1, 3, 8, and 9 based on the Examiner's above statement. As previously noted, Applicant's claims 1, 3, 8, and 9 call for a marker post comprising an "elongated member composed of a flexibly resilient polymer plastic." (Emphasis added.) The Applicant's marker post is used "to place as an above the ground warning that an underground pipe or electric line is buried in the soil."[11] (Emphasis added.) The elongated member of the Applicant's mark post includes flaps integrally connected to the marker post by living hinges.[12] The construction of the elongated member out of a flexibly resilient polymer plastic provides the hinges with sufficient flexibility "so that a user can bend the flaps out"[13] from a first closed position to a second

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[10] See page 5, lines 17-20 and page 6, lines 1-5 of Office Action dated March 28, 2003.

[11] See page 2, lines 8-9 of the Applicant's disclosure.

[12] See *id.* at page 4, lines 23-27.

[13] See *id.* at page 5, lines 1-2.

opened position for embedment in a topsoil surface. When embedded in the topsoil surface in the opened position, "the flap uses the weight of the top soil to create a resistance against the post becoming uplifted."[14]

The reference of Hanson discloses foundational support(s), and more specifically, a hollow metal piling pipe for supporting "buildings and similar housing structures,"[15] including "multi-level buildings weighing many tons"[16] thereon. (Emphasis added.) Unlike the Applicant's marker post, it is submitted that Hanson's piling pipe cannot be made from a resilient material such as "a flexibly resilient polymer plastic," as it is critical that Hanson's piling pipe be constructed of a material sufficiently strong to enable Hanson's piling pipe to support "buildings weighing many tons" thereon. The aforementioned is supported in column 3, lines 25-26 of the patent 5,494,378, wherein Hanson specifically teaches that his metal piling pipe:

> "may be of cylindrical thick walled metallic construction such as 1/4"-1/2" carbon steel and may be integrally formed or welded together at the construction site ..." (Emphasis added.)

In view of the above, it is submit that one in the art of foundational support for supporting "buildings weighing many tons" thereon would not have found the use of a flexible material such as a flexibly resilient polymer plastic obvious through the process of routine experimentation as stated by the Examiner since a flexibly resilient polymer plastic is not a

[14] See *id.* at page 5, lines 21-22.

[15] See column 1, lines 7-8, and 14-15 of Hanson '378.

[16] See *id.* at column 1, lines 10-11.

material suitable for use in forming pilings for supporting "buildings weighing many tons" thereon.

In further regards to the Examiner's rejection of Applicant's claims 1, 3, 8 and 9 due to obviousness in forming Hanson's piling from a flexible material such as flexibly resilient polymer plastic, note that in the case of *In re Fritch,* the C.A.F.C stated:

> "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."[17] (Emphasis added.)

As the reference of Hanson does not suggest the desirability of forming Hanson's piling from a flexible material such as a flexibly resilient polymer plastic but instead teaches away from the aforementioned through Hanson's teaching of his piling as being made from a metallic material such as "carbon steel,"[18] it is respectfully submitted that the it would not have been obvious, in view of *In re Fritch*[19], to form Hanson's piling from a flexibly resilient polymer plastic as suggested by the Examiner.

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[17] See *In re Fritch*, 23 USPQ2d 1780, 1783-84 (C.A.F.C. 1992), citing *In re Gordon.*, 221 USPQ 1125, 1127(Fed. Cir. 1984); also see *Carl Schneck, A.G. v. Norton Corp., 218 USPQ 698, 702 (Fed. Cir. 1983), and In re Serbaker,* 217 USPQ 1, 6-7 (Fed. Cir.1983), both citing In re Imperato, 179 USPQ 730, 732 (CCPA 1973).

[18] See column 3, lines 25-26 of Hanson.

[19] See *In re Fritch*, 23 USPQ2d 1780, 1783-84 (C.A.F.C. 1992), citing *In re Gordon.*, 221 USPQ 1125, 1127(Fed. Cir. 1984); also see *Carl Schneck, A.G. v. Norton Corp., 218 USPQ 698, 702 (Fed. Cir. 1983), and In re Serbaker,* 217 USPQ 1, 6-7 (Fed. Cir.1983), both citing In re Imperato, 179 USPQ 730, 732 (CCPA 1973).

In regards to the Examiner's citation of the case of *In re Leshin*, it is submitted that *In re Leshin* does not apply to the present case since in *In re Leshin*, the CCPA found that it was obvious to make a metal lip stick container of plastic since prior lip stick containers had been made of plastic. *In re Leshin* involved a device comprising:

> "a combination of mechanical elements constituting a mechanism superficially resembling the common lipstick holder except that the cosmetic body of sticklike form has a follower embedded in its lower end and is moved by turning a knob attached to the threaded stem which is disposed axially of and inside the stick of cosmetic." [20]

In *In re Leshin*, the Appellant acknowledges that the cited prior art of Root:

> "which shows a metal lip stick container[21], "does disclose Applicant's general structure but lacks Applicant's double seal at the bottom of the container, as well as Applicant's molded plastic materials."[22] (Emphasis added.)

The CCPA held that the:

> "Mere selection of known plastics to make a container-dispenser of a type made of plastics prior to the invention, the selection of the plastic being on the basis of suitability for the intended us, would be entirely obvious..."[23] (Emphasis added.)

In a nutshell, the C.C.P.A. in *In re Leshin* held that although the prior art reference of Root shows a metal lip stick container and the appellant's device (which superficially resembles a

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[20] See *In re Leshin*, 125 USPQ 416, 417 (CCPA 1960).

[21] See *id.*

[22] See *id.*

[23] See *id* at 417-18.

common lip stick container[24]) is made from molded plastic materials, it would have been obvious to make the Root lip stick container of a plastic materials as prior lip stick container have been made from plastic materials, thus suggesting the modification.

In contrast to *In re Leshin*, it is submitted that the cited art of Hanson does not teach his piling as being formed from a flexible material such as a flexibly resilient polymer plastic. It is further submitted that Hanson's field of art, namely foundation support for supporting "buildings weighing many tons" [25] thereon, also does not teach forming foundation support from a flexible material such as a flexibly resilient polymer plastic as a flexibly resilient polymer plastic foundation support would not be sufficiently strong to enable the aforementioned foundation support to support "buildings weighing many tons" thereon.

It is for the above reasons that the Applicant submits that Applicant's marker post comprising an elongated member composed of a flexibly resilient polymer plastic is not made obvious by Hanson's metal piling pipe.

3. The flexible living hinges of the Applicant's marker post are not made obvious by the metal anchor tabs of Hanson's metal piling.

Applicant's claims 1, 2, and 8 each call for flexible living hinges for attaching the anchoring flaps to the elongated member, the flexible living hinge facilitating the movement of the

[24] See *id.*

[25] See column 1, lines 10-11 of Hanson '378.

anchoring flaps from a first closed position, for handling and transportation of the marker post, to a second open position for preventing the withdrawal of the elongated member from an embedded position.

In rejecting Applicant's claims 1, 2, and 8 as being made obvious by the reference of Hanson, the Examiner indicated that Hanson's Figure 1 discloses the Applicant's flexible living hinge.[26] Referring more specifically to page 2, line 19 of the Office Action dated March 28, 2003, note that the Examiner specifically identifies Hanson's anchor tabs 14 as being "a first flexible living hinge." (Emphasis added.)

The Applicant respectfully disagrees with the Examiner's above rejection of Applicant's claims 1, 2, and 8.

It is submitted that Hanson's anchor tabs 14, as shown in his Figure 14, and the Applicant's flexible living hinges are two different components. As stated above, Applicant's flexible living hinges are for facilitating the movement of the anchoring flaps from the first closed position to the second open position. Hanson's anchor flaps, on the other hand, are for enhancing the gripping power of the piling to enhance the support force of Hanson's piling. More specifically, note in column 3, lines 7-24 of the '378 patent wherein Hanson teaches that the detonation of charges located within his piling 10 locks his:

[26] See page 2, lines 12-13,19-23; page 3, lines 10-18; and page 5, lines 4-13 of the Office action dated March 28, 2003 wherein the Examiner specifically states: "... and a first flexible living hinge (Fig. 4, anchor tabs), ..."

"tabs 14 in their extended position shown in FIGS. 6 and 7, thereby substantially enhancing the gripping power of the piling to enhance the support force provided thereby."[27] (Emphasis added.)

The Applicant submits that flexible living hinges for facilitating the movement of the Applicant's flaps are different from anchor tabs for enhancing the gripping power of the piling to enhance the support force.

In further regards to the above, note that the Applicant's flexible living hinges are an integral part of the Applicant's elongated member composed of a flexibly resilient polymer plastic. As such, it is submitted that the Applicant' living hinges are also composed of a flexibly resilient polymer plastic. The flexibly resilient polymer plastic provides the hinges with sufficient flexibility "so that a user can bend the flaps out ..."[28] (Emphasis added.) In contrast to the aforementioned, Hanson specifically teaches that his anchor flaps as being composed of a metallic material such as 1/4"-1/2" thick carbon steel.[29] It is submitted that 1/2" thick carbon steel anchor flaps 14 are not sufficiently flexible to be bent by a user, which is why Hanson requires the use of the charge explosive to bend his anchor flaps 12 outwardly.

In view of the above, it is submitted that the flexible living hinges of the Applicant's marker post are not made obvious by the metal anchor tabs of Hanson's metal piling pipe.

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[27] See specifically column 3, lines 21-24 of Hanson.

[28] See page 4, line 27 and page 5, lines 1-2 of the Applicant's disclosure.

[29] See for example Figures 4 and 6 and column 2, line 58 and column 3, lines 25-26 of Hanson.

4. **The reference of Hanson does not teach a marker post having anchoring flaps moveable from a first closed position to a second open position wherein the flaps have "sufficient memory to stay in the open position until the post can be embedded" within a top soil to prevent the withdrawal of the elongated member from an embedded position.**

Applicants claim 8 calls for a marker post having integral anchoring flaps:

> "moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said elongated member from an embedded position whereby the flaps has a sufficient memory to stay in the open position until the post can be embedded." (Emphasis added.)

That is, the flaps of the Applicant's marker post are bent out from the first closed position to the second open position before the marker post is embedded along with the flaps within a top soil surface. The embedment of the flaps of the Applicant's marker post in the second open position within the top soil surface results in the flaps creating a resistance against up-lifting of the post marker.

It is submitted that the reference of Hanson does not teach the above. Hanson instead, teaches the contrary by disclosing that his piling pipe is driven into the soil with the fingers of his piling pipe being in the retracted position. It is only after Hanson's piling pipe is embedded in the soil in the retracted position are Hanson's fingers fanned "... radially outwardly to be embedded into the surrounding soil..."[30]

[30] See column 2, lines 15-17 of Hanson 5,494,378.

Further note that unlike the Applicant's anchoring flaps which may be move from the first closed position to the second open position by a user, the fingers of Hanson's piling pipe are not fanned "radially outwardly" by a user. Instead, Hanson specifically teaches the use of a "chain of explosive charges"[31] to fan out the fingers of his metal piling. There are two reasons why Hanson requires the use of "chain of explosive charges" to fan out the fingers of his metal piling. The first reason is that since Hanson embeds his metal piling before his fingers are fanned radially outward, the embedment of his metal piling restricts the user's access to the fingers of his metal piling pipe.

The second reason Hanson requires the use of "chain of explosive charges" to fan out the fingers of his metal piling is due to the material, which Hanson uses in forming his anchoring finger. As previously noted, Hanson specifically teaches that his "piling pipe 12 may be cylindrical thick walled metallic construction such as 1/4" – 1/2" carbon steel ..."[32] (Emphasis added.) Hanson further teaches that his "anchor fingers 30, for a conventional piling of about 12 inches in diameter, may be about 3-1/2 inches long and about 1-1/2 inches wide at their widest point."[33] (Emphasis added.) It is submits that anchoring fingers that are 3-1/2 inches long, 1-1/2 inches wide, and formed from 1/2" carbon steel cannot be fanned "radially outwardly" by a user.

In regards to the Examiner's comments on page 6, lines 1-15 of the Office Action dated March

[31] See *id.* at column 2, lines 11-12.

[32] See *id.* at column 3, lines 25-26.

[33] See column 4, lines 18-20 of Hanson 5,494,378.

28, 2003 that Applicant's claim 8 contains a "whereby" statement and that the aforementioned statement "does not define any structure and accordingly can not serve to distinguish," the disagrees.

Although Applicant agrees that when the word "whereby" merely states a result of the invention recited in the claim, that the aforementioned will not generally limit the claim. However, note that the word "whereby" in Applicant's claim 8 is accompanied by a phrase that does not merely states a result of the invention but instead sets forth a positive structural limitation for the invention recited in the claim, namely, that the flaps of the elongated member of the marker post "has a sufficient memory to stay in the open position until the post can be embedded."

Referring to the case of *Scheinman v. Zalkind*[34], note that in holding that the word "whereby" and its accompanying phrase may limit a claim if the word "whereby" and its accompanying phrase set further a structural limitation for the invention recited in the claim, the C.C.P.A. stated:

> "We agree with the board that the particular clauses involved here are structural in character and import into the [1] count the structural features which both parties sought to produce. While other language could have been used which might have been clearer, it is not thought that the questioned clauses are merely functional or that the count as a whole is misleading." [35] (Emphasis added.)

In view of the above, since the word "whereby" in Applicant's claim 8 is accompanied by a

[34] See *Scheinman v. Zalkind*, 46 USPQ 141 (C.C.P.A. 1940).

phrase that sets a positive structural limitation to the claim, namely, that the "flaps has a sufficient memory to stay in the open position until the post can be embedded," it is respectfully submitted that the aforementioned phrase may serve to distinguish Applicant's claim 8 over the cited art.

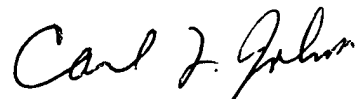
It is for the above reasons that the Applicant submits that the reference of Hanson does not teach a marker post having anchoring flaps moveable from the first closed position to the second open position wherein the flaps have "sufficient memory to stay in the open position until the post can be embedded" within a top soil to prevent the withdrawal of the elongated member from an embedded position.

In summary, it is submitted that the Examiner has erred in rejecting Applicant's claims 1-12 under 35 U.S.C. 103(a) as being anticipated by the reference of Hanson (U.S. Patent No. 5,494,378). Accordingly, it is respectfully requested that the decision of the Examiner be reversed and that Applicant's claims 1-12 be allowed.

[35] See *Scheinman v. Zalkind*, at 143. (Note that the particular clauses which the C.C.P.A. is referring to is the "whereby" clause.)

Respectfully submitted,

JACOBSON AND JOHNSON

By 

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Enclosures

IX. APPENDIX

Appealed Claims.

I claim:

1. A marker post comprising:

a. a hollow elongated member, said elongated member composed of a flexibly resilient polymer plastic, said elongated member having a first end and a second end;

b. a first integral anchoring flap, said anchoring flap having a first end and a second end, said anchoring flap located proximate the second end of said elongated member; and

c. a first flexible living hinge, said anchoring flap attached to the elongated member at the second end of said anchoring flap by said first flexible living hinge, said anchoring flap moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said elongated member from an embedded position.

2. The marker post of claim 1 including:

a. a second integral anchoring flap and a third integral anchoring flap, said second integral anchoring flap and said third integral anchoring flap each having a first end and a second end, said second integral anchoring flap and said third integral anchoring flap each located proximate the second end of said elongated member, said first integral anchoring flap and said second integral anchoring flap and said third integral anchoring flap circumferentially positioned around the said elongated member; and

b. a second flexible living hinge and a third flexible living hinge, said second integral anchoring flap attached to the elongated member at the second end of said second integral

anchoring flap by the second flexible living hinge, said third integral anchoring flap attached to the elongated member at the second end of said third integral anchoring flap by the third flexible living hinge, said second integral anchoring flap and said third integral anchoring flap moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said elongated member from an embedded position.

3. The marker post of claim 1 wherein said polymer plastic is polycarbonate or polyethylene.

4. (Amended 9/02) The marker post of claim 1 wherein said elongated member is triangular, circular, rectangular or square shaped and said elongated member includes a non-tapered exterior surface.

5. (Amended 9/02) The marker post of claim 1 wherein said elongated member and said anchoring flap are weather resistant and said anchoring flap is in a coplanar condition with said marker post when said anchoring flap is in a closed position.

6. The marker post of claim 1 including a weather resistant cap for covering the first end of said elongated member to prevent rain or snow from entering the elongated member.

7. (Amended 9/02) The marker post of claim 1 wherein said elongated member is sufficiently stiff to permit the marker post to be driven into a top layer of soil.

8. (Twice Amended) A hollow anchoring marker post comprising:

a. a triangular shaped elongated member having a first panel, a second panel, and a third panel forming the elongated member, said elongated member composed of a flexibly resilient polymer plastic, said triangular shaped elongated member having a first open end and a second open end;

b. a first anchoring flap, a second anchoring flap, and a third anchoring flap, each of said anchoring flaps having a first end and a second end, each of said anchoring flaps integrally connected to said elongated member, each of said anchoring flaps located proximate a second end of said elongated member; and

c. a first flexible living hinge, a second flexible living hinge, and a third flexible living hinge; the second end of said first anchoring flap attached to the first panel of said elongated member by said first flexible living hinge, the second end of said second anchoring flap attached to the second panel of said elongated member by said second flexible living hinge, the second end of said third anchoring flap attached to the third panel of said elongated member by said third flexible living hinge, each of said anchoring flaps moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said elongated member from an embedded position whereby the flaps has a sufficient memory to stay in the open position until the post can be embedded.

9. (Twice Amended) The hollow one piece anchoring marker post of claim 8 wherein said polymer plastic is polycarbonate or polyethylene.

10. (Twice Amended) The hollow one piece anchoring marker post of claim 8 wherein said elongated member is sufficiently stiff to permit the marker post to be driven into a top layer of soil.

11. The marker post of claim 7 wherein said elongated member and said anchoring flaps are weather resistant.

12. The marker post of claim 7 including a weather resistant cap for covering the first end of said elongated member to prevent rain or snow from entering the elongated member.